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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,178	10/23/2001	Clifton Lind	108-988	6355

35236 7590 06/23/2004  
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EXAMINER

CAPRON, AARON J

ART UNIT PAPER NUMBER

3714

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/037,178

Applicant(s)

LIND ET AL.

Examiner

Aaron J. Capron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-14,16-22 and 24-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-14,16-22 and 24-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This is a response to the Request for Reconsideration received on March 18, 2004.

Claims 1, 3-14, 16-22 and 24-42 are pending.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-14, 16-22, 24-29 and 38-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier (U.S. Patent No. 5,871,398) in view of Novak (U.S. Patent No. 5,239,165).

Referring to claims 1 and 3, Schneier discloses a gaming method including the steps of creating a player account for a player, the player having an account balance (11:23-32); receiving a game ticket request from a player, the game ticket request identifying a play quantity, the play quantity comprising a value representing a quantity of game play outcomes to be obtained (9:50-57); determining if the account balance for the player account is sufficient for the play quantity (5:11-14); and in the event that the account balance for the player account is sufficient for the play quantity, each ticket indicia corresponding to a particular one of the game records, and representing the respective game play outcome associated with the particular one of the game records (the ticket being the AGAM: 9:57-10:4). Schneier discloses the game play information being in machine readable form and specifying each game play outcome represented on the game

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ticket (13:61-14:8 and 1:42-2:7), but does not apply a number of ticket indicia to a ticket substrate to produce a game ticket, each ticket indicia being directly identifiable. However, Novak discloses a printer applying a number of ticket indicia to a ticket substrate to produce a lottery ticket (9:34-41 and Figures 10-12). One would be motivated to provide ticket-printing capabilities to Schneier in order to satisfy the needs of players that would prefer to play lotto type games instead of a predetermined lottery game. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the ticket printer of Novak into the lottery system of Schneier in order to satisfy the needs of players that would prefer to play a lotto-style lottery game instead of a predetermined lottery game.

Referring to claim 4, Schneier discloses the step of applying the game play information includes applying a first value representing a sequential value correlated to a first game play outcome represented on the game ticket (Figure 10); and applying a second value representing the play quantity (17:53-67).

Referring to claim 5, Schneier discloses the step of applying the game play information includes applying a ticket identifier to the game ticket (14:1-3) and further including the step of recording in a data storage device separate from the game ticket a set of ticket data correlated to the ticket identifier, the set of ticket data identifying each game play outcome represented on the game ticket (Figure 3).

Referring to claim 6, Schneier discloses the steps of distributing the game ticket to the player; reading the game play information from the game ticket at a player terminal (Figure 1); and for at least one game play outcome represented on the game ticket, displaying a graphic game representation indicating the respective game play outcome represented on the game ticket,

each respective graphic game representation being displayed in response to a respective player input made after the step of reading the game play information at the player terminal (5:56-6:19).

Referring to claim 7, Schneier discloses the step of displaying the graphic game representation comprises displaying a representation related to a casino type game (5:56-6:19: bingo or poker).

Referring to claim 8, Schneier discloses the steps of deducting a cost associated with each respective game play outcome represented on the game ticket substantially concurrently with the step of applying the ticket indicia to the ticket substrate and adding a payoff amount associated with at least one game play outcome in response to a ticket redemption request initiated by the player (11:23-32 and 20:10-52)

Referring to claim 9, Schneier discloses that each ticket indicia includes an outcome code selected from a set of available codes for a game being played (10:33-58).

Referring to claim 10, Schneier discloses the step of displaying a prize table in which each outcome code in the set of available outcome codes is associated with a prize level in the game (5:56-6:5 and 1:42-2:9). In the alternative, should Schneier be interpreted as not disclosing this step, the Examiner takes Official Notice that a prize table for a casino type lottery game or a pulltab type game is well known within the art. One would be motivated to provide a prize table into the invention of Schneier and Novak in order for the player to determine their own winnings. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a prize table into the lottery game of Schneier and Novak, in light of the Official Notice taken, in order to allow a player to determine their own winnings.

Referring to claim 11, Schneier discloses the steps of distributing the game ticket to the player; reading the game play information from the game ticket at a point of sale terminal after the game ticket is distributed to the player; and providing the player with a result of the game ticket after reading the game play information (Figure 8).

Referring to claim 12, Schneier discloses the step of applying a cover material to the ticket substrate, the cover material obscuring each ticket indicia applied to the ticket substrate (5:56-6:5 and 2:10-29). In the alternative, should Schneier be interpreted as not disclosing this step, the Examiner takes Official Notice that a cover material covering the ticket indicia and substrate is well known within the art. One would be motivated to provide a cover material to cover the ticket indicia in order to create excitement for the player due to the anticipation of a possible winning outcome. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a cover material to the lottery game of Schneier and Novak, in light of the Official Notice taken, in order to create excitement for the player due to the anticipation of a possible winning outcome.

Referring to claim 13, Schneier discloses the step of applying each ticket indicia to the ticket substrate through a cover material that obscures each respective ticket indicia (5:56-6:5 and 2:10-29).

Claims 14 and 16-21 correspond in scope to a medium set forth for use of the method listed in claims listed above and are encompassed by use as set forth in the rejection above.

Claims 22 and 24-29 correspond in scope to a medium set forth for use of the method listed in claims listed above and are encompassed by use as set forth in the rejection above.

Claims 38-42 correspond in scope to a medium set forth for use of the method listed in claims listed above and are encompassed by use as set forth in the rejection above. Schneier discloses that the player terminal can be physically connected for communication with the ticket data storage device by being able to be connected to the AT (Figure 1, items 26 and 92, 11:57-12:7) or by directly connecting the CMT (Figure 12). Schneier further discloses the ticket usage information to the CMC in order to keep a player's account accurate by determining whether a ticket on an HTV has been played and was a winner (11:23-32).

### ***Response to Arguments***

Applicant's arguments filed March 18, 2004 have been fully considered but they are not persuasive.

Applicant argues that Novak does not disclose a predetermined game having any stored game records associated with a game play outcome nor does it teach or suggest printing ticket indicia on any ticket where each indicia represents the respective game play outcome associated with a particular one of the stored game records. First, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., predetermined outcome lottery game) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Second, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413,

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208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Schneier in view of Novak discloses storing game records each associated with the game play outcome (Schneier Figure 3) in order to verify each winning ticket (5:56-6:20). Third, Novak describes having ticket indicia (lotto numbers) wherein each number represents the respective game play outcome associated with stored game records described in Schneier. Therefore, the claimed invention fails to preclude the invention of Schneier and Novak.

Applicant argues that the HTV's of Schneier do not maintain communication with any other part of the system during the course of play. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., maintain communication) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The term operatively equates to functioning effectively. Schneier's HTV effectively communicates with the AT since the HTV communicates when it needs to relay information. In addition, Schneier discloses that the AT and the CMC can be the same device (6:20-31) wherein the CMC is the ticket data storage device. Therefore, the claimed invention fails to preclude the invention of Schneier and Novak.

Applicant argues that there is no proper way to combine Schneier and Novak. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one would be motivated to provide ticket-printing capabilities to Schneier in order to satisfy the needs of players that would prefer to play lotto type games instead of a predetermined lottery game. Therefore, the claimed invention fails to preclude the invention of Schneier and Novak.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Definition of operative.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ajc



JESSICA HARRISON  
PRIMARY EXAMINER